IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

PHOTOGRAPHIC ILLUSTRATORS CORPORATION, Plaintiff, v. INTERNATIONAL LIGHTING CORP. D/B/A INTERLIGHT, Defendant.	Civil Action No.: 1:14-CV-14256-LTS

PLAINTIFF'S OPPOSITION TO DEFENDANT'S MOTION TO DISMISS

The Court should deny Interlight's motion to dismiss Count III of PIC's Complaint (PIC's Lanham Act claims). Interlight's motion is based entirely on *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003). *Dastar*, however, does not foreclose relief under the Lanham Act where Interlight placed false attribution (i.e., its "www.interlight.biz" watermark) on PIC photographs and used them in commerce. To the contrary, *Dastar* expressly concluded that such misconduct does support a Lanham Act claim: "That claim [under Lanham Act § 1125(a)(1)(A)] would undoubtedly be sustained if Dastar had bought some of New Line's Crusade videotapes and merely repackaged them as its own." 539 U.S. at 31 (emphasis added).

I. INTRODUCTION

A. Factual Background

PIC is a prominent commercial photography studio, in business since the 1960s. PIC has done high quality product photography for clients such as Osram Sylvania, Inc. ("Sylvania") for many years, creating a portfolio of thousands of valuable images in the process.

PIC's photographs have gained significant recognition in the marketplace, due in part to PIC's longstanding practice of associating the names "P.I. Corp." and "Paul Kevin Picone" with all of its images as copyright management information. (D.I. 1 at ¶¶ 21, 442-43). This practice has allowed consumers of PIC's services – including Sylvania, whose products are depicted in the 40 photographs referenced in the Complaint (the "PIC Images") – to associate the P.I. CORP. and PAUL KEVIN PICONE marks (the "PIC Marks") with PIC's high-quality photography services. (*Id.* at ¶¶ 14, 21, 442-43).

PIC relies on its copyright management information, in the form of the PIC Marks, as its primary mode of advertising. (*Id.* at ¶ 444). Potential customers seek out and contact PIC using this information. (*Id.*).

As set forth in the Complaint, Interlight removed PIC's copyright management information from the PIC Images and added its own false information in the form of the "www.interlight.biz" watermark. (*Id.* at ¶ 24). An illustrative example appears at paragraph 30 of the Complaint:

<table>
<tr><th>PIC Image</th><th>Interlight's Infringing Copy</th></tr>
<tr><td>

29121 CF4 EL decor.tif</td><td>
SYLVANIA
www.interlight.biz

</td></tr>
</table>

By removing PIC's copyright management information, Interlight deprived PIC of its primary advertising vector and business opportunities that would have arisen therefrom. (*Id.* at ¶ 446).

By replacing the PIC Marks with the false Interlight watermark, Interlight created a likelihood that consumers – and potential PIC customers – would mistakenly believe that Interlight is the source, owner, and creator of the PIC Images. (*Id.* at ¶¶ 447 and 464).

B. PIC's Lanham Act Pleading

The Lanham Act provides, under 15 U.S.C. § 1125(a), two related causes of action for using – "in commerce" and "in connection with any goods or services" – "any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact" when:

- likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person (§ 1125(a)(1)(A)); or
- in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities (§ 1125(a)(1)(B)).

PIC's Complaint pled that Interlight used the PIC Images in commerce in connection with the sale of Interlight's goods and services. (D.I. 1 at ¶ 462). PIC also pled that Interlight placed a false designation, "www.interlight.biz", over the PIC Images that it used. (*Id.* ¶ 24). PIC also pled that, because of Interlight's misconduct, customers familiar with PIC's extensive and recognizable work for Sylvania are likely to believe, incorrectly, that Interlight and PIC are affiliated, connected, or associated, and that PIC sponsors or approves of Interlight's goods, services, or commercial activities, in violation of § 1125(a)(1)(A). (D.I. 1 at ¶ 465). PIC also pled that Interlight's misconduct occurs in commercial advertising, misrepresenting the nature, characteristics, qualities, or geographic origin of Interlight's or PIC's goods, services, or commercial activities, in violation of § 1125(a)(1)(B). (D.I. 1 at ¶ 466). In short, PIC pled every element of Lanham Act claims under both §§ 1125(a)(1)(A) and 1125(a)(1)(B).

II. LEGAL STANDARD

"The general rules of pleading require a short and plain statement of the claim showing that the pleader is entitled to relief." *Gargano v. Liberty Intern. Underwriters, Inc.*, 572 F.3d 45, 48-49 (1st Cir.2009) (internal citations and quotation marks omitted). This short and plain statement need only "give the defendant fair notice of what the ... claim is and the grounds upon which it rests." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). To survive a motion to dismiss under Rule 12(b)(6), "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). "In considering a motion to dismiss, a court must take the allegations in the complaint as true and must make all reasonable inferences in favor of the plaintiffs." *Watterson v. Page*, 987 F.2d 1, 3 (1st Cir. 1993). The allegations must, "if taken as true, set forth a plausible, not merely a conceivable, case for relief." *Juarez v. Select Portfolio Servicing, Inc.*, 708 F.3d 269, 276 (1st Cir. 2013). If plaintiff(s) allege facts sufficient to "nudge[] their claims across the line from conceivable to plausible," dismissal is improper. *Twombly*, 550 U.S. at 570.

III. ARGUMENT

Interlight argues, in two conclusory paragraphs, that its misconduct in claiming the PIC Images as its own, through application of a false designation, is not actionable under the Lanham Act. Citing *Dastar*, Interlight argues that because PIC's photographic images are "creative works" rather than "tangible goods," PIC's only remedy lies under the Copyright Act.

Dastar and its progeny, however, establish the opposite – namely, that repackaging another author's work as one's own (misconduct that was not at issue in *Dastar* itself) "would undoubtedly be sustained" as a violation of § 1125(a)(1)(A). *Dastar*, 539 U.S. at 31. Moreover, photographs are unquestionably "tangible goods" as numerous post-*Dastar* cases have held.

Interlight's brief does not even address § 1125(a)(1)(B) – likely because the First Circuit has already concluded that *Dastar* did not foreclose liability under that section for false authorship claims. *Zyla v. Wadsworth,* 360 F.3d 243, 252 n.8 (1st Cir. 2004) ("The Court in *Dastar* left open the possibility that some false authorship claims could be vindicated under the auspices of § 43(a)(1)(B)'s prohibition on false advertising.").

A. *Dastar* Expressly Stated That Repackaging Another Author's Work As One's Own Is a Violation of Lanham Act § 1125(a)(1)(A).

In *Dastar,* the holder of an expired copyright in an old television series about the Second World War sued a company (Dastar) that had produced a new series based on the original. Dastar had taken the original series from the public domain (since the copyright was expired) and exercised creativity in editing it to prepare the new series. Dastar's edited version was only half as long as the original, and included a new opening sequence, new chapter title sequences, new narrated chapter introductions, and other changes. *Dastar,* 539 U.S. at 26-27. Dastar sold its new version of the series as its own product, without crediting the owner of the expired copyright in the original. *Id.* at 27.

Because of Dastar's creative changes to the original series, and also in part because the original series was "uncopyrighted" and thus "in the public domain" in the first place, the Court concluded that it was literally correct (and thus not misleading) for Dastar to credit itself as the creator of the series. *Id.* at 26, 27, 35. The Court was careful, however, to expressly distinguish situations – like the present case – in which one party attempts to claim credit for creating another party's work. The Court concluded that a Lanham Act claim under Section 1125(a)(1)(A) "would undoubtedly be sustained if Dastar had bought some of [the original series] videotapes and merely repackaged them as its own." *Id.* at 31. That is exactly what Interlight did.

Subsequent case law confirms that claiming ownership over another party's work – including photographs (which are "tangible goods") – violates § 1125(a)(1)(A). For example, in *Cable v. Agence France Presse*, 728 F. Supp. 2d 977 (N.D. Ill. 2010), a photographer sued for use of his photographs by a third party without proper attribution. *Id.* at 979 ("Cable alleges that AFP caused these photos to be copied … [and] also alleges that AFP deliberately removed Cable's photo credit and copyright notice."). The defendant, AFP, made precisely the same argument as Interlight, namely that *Dastar* "precludes this claim." *Id.* at 981. The court rejected that argument, and denied the defendant's motion to dismiss the Lanham Act claim.

> However, the *Dastar* court also limited its ruling in one important way—it stated that a claim under § 43(a) "would undoubtedly be sustained if Dastar had bought some of New Line's Crusade videotapes and merely repackaged them as its own." *Id.* at 31, 123 S.Ct. 2041. This is what the plaintiff has alleged—that AFP took the plaintiff's photos and repackaged them as their own without revision. Accordingly, the court denies the motion to dismiss the Lanham Act claim.

Id.

Similarly, in *Defined Space, Inc. v. Lakeshore E., LLC*, 797 F. Supp. 2d 896 (N.D. Ill. 2011), a photographer brought suit against the defendants for using his photographs without proper attribution. The court also denied the defendants' motion to dismiss the Lanham Act claim, based on *Dastar*, after concluding that "the defendants took DSI's photographs and passed them off as their own photographs without revision[1] or proper accreditation." *Id.* at 901.

Notably, the photographers in *Cable* and *Defined Space* merely alleged removal of their photo credits and copyright notices. Unlike PIC, they did not allege that the defendant committed the additional misconduct of affirmatively claiming the photograph as its own. PIC's claim that Interlight used "in commerce any word, term, name … or any false designation of origin" is thus even stronger. 15 U.S.C. § 1125(a)(1).

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[1] While Interlight made changes to some of the PIC Images, the changes were minor and cosmetic and solely to hide Interlight's infringement. (D.I. 1 at ¶¶ 23-25; *see also, e.g., id.* at ¶ 100).

In *Levine v. Landy*, Levine alleged that Landy used certain of his photographs in a book without his permission, in some cases omitting any mention of Levine as the photographer, and in other cases affirmatively misrepresenting that Landy was the photographer. 832 F. Supp. 2d 176, 181 (N.D.N.Y. 2011). After acknowledging *Dastar*, the court summarized Levine's claims in a manner that directly parallels PIC's claims here, and denied Landy's motion to dismiss.

> Levine asserts defendants inaccurately represented some of the photographs as taken by Landy. This is sufficient to allege false designation of origin, in that plaintiff alleges false representation as to the creator of the works. Levine also alleges the public has been mislead as to the true origin of the photographs and that he has been, and will continue to be, damaged by the false designation. Accordingly, plaintiff adequately pleads a Lanham Act claim which is not preempted by the Copyright Act based on these allegations. Because this analysis is heavily fact dependent, defendants' motion to dismiss based on preemption will be denied.

Id. at 191.

Interlight's only post-*Dastar* case, *Steele v. Turner Broad. Sys.*, 607 F. Supp. 2d 258, 263 (D. Mass. 2009), is inapposite. In Steele, a *pro se* litigant claimed a Lanham Act violation for alleged unauthorized use of a song that he wrote. Because Steele was unable to identify a tangible good to which attribution (proper or not) could have been attached, the Lanham Act claim could not go forward. *Id.* at 262-263. In this case, by contrast, Interlight copied and used PIC's photographs with Interlight's own false claim of authorship. This case is on all fours with *Cable*, *Defined Space*, *Levine*, and the Supreme Court's unambiguous guidance in *Dastar* itself

B. Interlight's Misconduct Also Violates Lanham Act § 1125(a)(1)(B).

PIC also alleges that Interlight violated 15 U.S.C. § 1125(a)(1)(B). (D.I. 1 at ¶ 466). As recognized by the First Circuit, "[t] he Court in *Dastar* left open the possibility that some false authorship claims could be vindicated under the auspices of § 43(a)(1)(B)'s prohibition on false advertising." *Zyla* 360 F.3d at 252 n.8.

Interlight's motion to dismiss fails even to address Section 1125(a)(1)(B). *Zyla* indicated that to make out a claim under this section, a plaintiff must plead "that the [use] was a form of commercial advertising or promotion." 360 F.3d at 252 n.8. PIC did so. (D.I. 1 at ¶ 466). Indeed, PIC's Complaint even included screenshots of Interlight's website, showing the same. (D.I. 1 at ¶¶ 30-435). Thus, Interlight's motion to dismiss should be denied for the additional and independent reason that PIC's well-pled complaint states a claim for violation of Section 1125(a)(1)(B) of the Lanham Act, a point that Interlight did not even contest in its motion.

IV. CONCLUSION

For the above reasons, Interlight's motion to dismiss Count III of PIC's Complaint should be denied.

Respectfully submitted,

PHOTOGRAPHIC ILLUSTRATORS CORPORATION,

By its counsel,

Dated: February 19, 2014

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CERTIFICATE OF SERVICE

I certify that this document is being filed through the Court's electronic filing system, which serves counsel for other parties who are registered participants as identified on the Notice of Electronic Filing (NEF). Defendant is being served on the date of electronic filing.

/s/ *Michael N. Rader*
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